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EXAMINER

SANTOS, PATRICK J D

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,311

Applicant(s)

SHAY ET AL.

Examiner

Patrick J Santos

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-16, and 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,870,089 issued to Fabbio et al. (hereafter Fabbio '089) in view of U.S. Patent No. 5,031,214 issued to Dziewit et al. (hereafter Dziewit '214) and in further view of the web page, [www.legalstar.com](http://www.legalstar.com) as archived by the WAYBACK MACHINE (TM) ([www.archive.org](http://www.archive.org)) on April 21, 1999 (hereafter LegalStar '99).

#### Claims 1, 32, and 34:

Regarding Claims 1, 32, and 34, Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses:

- (Claim 1) a computer-implemented method (Fabbio '089: col. 10, ln. 8);
- (Claim 32) a computer system for controlling document edits, the computer system comprising a processor and a computer readable medium comprising instructions executable by the processor (Fabbio '089: col. 12, ln. 60);
- (Claim 34) a computer program embodied on a computer readable medium, the computer program comprising instructions executable by a computer (Fabbio '089: col. 14, ln. 18);

comprising:

- storing a plurality of alterable electronic documents on a computer system (Fabbio '089: col. 2, lns. 56-65); and
- receiving from a user a first signal indicating that one or more of the electronic documents are to be filed (Fabbio '089: col. 6, lns. 6-8; col. 6, lns. 43-44 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating electronic documents are to be filed; further note the user creates signals to populate the package attributes).

However, Fabbio '089 does not explicitly disclose:

- automatically locking the one or more electronic document into a non-editable form;
- the electronic documents are associated with a patent application;
- or that the filing of the electronic documents is with a patent office.

Dziewit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziewit '214 discloses: a computer-implemented method of controlling document edits (Dziewit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) including:

- automatically locking the one or more electronic document into a non-editable form (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55).

However, Dziewit '214 does not disclose that the electronic documents are associated with a patent application; or that the filing of the electronic documents is with a patent office.

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to apply the electronic document locking means of Dziewit '214 to the electronic document package distribution means of Fabbio '089. The motivation to combine is suggested by Dziewit '214 which discloses that use of the electronic document locking means of Dziewit '214 provides the advantage of guaranteeing the "legal document authentication and authenticity requirements traditionally associated with printed documents" (Dziewit '214: col. 3, lns. 14-22) such as with documents in the electronic document package means of Fabbio '089.

It would have been further obvious to a person having ordinary skill in the art to apply the Fabbio '089 and Dziewit '214 combination for electronic filing of patent documents as per LegalStar '99. The motivation to combine is suggested by Dziewit '214 which discloses that use of Fabbio '089 and Dziewit '214 in combination provide the advantage of rendering electronic documents such as that of LegalStar '99 the degree of trust associated with paper documents, thus providing for the automation of the patent application process (Dziewit '214: col. 1, ln. 60 to col. 2, ln. 2).

Claims 2-5, 9, and 11:

Regarding Claims 2-5, 9, and 11, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 1 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 2) further comprising storing the one or more electronic documents in a package prior to generating the first signal (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that “one or more pieces of information” reads on one or more electronic documents – also see Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 3) further comprising allowing a user to perform a manual verification of the locked electronic documents prior to filing the documents in the patent office (Dziewit '214: col. 10, lns. 1-12 – note that individual document editing, which reads on a manual verification of an electronic document, is prior to the communications step described in col. 10, lns. 15-58).
- (Claim 4) further comprising electronically filing the electronic documents in the patent office (Fabbio '089: col. 3, lns. 4-23 – note that Fabbio '089 supports forwarding an electronic document package to an arbitrary destination, and explicitly supports targeting a mail queue that will electronically transmit the electronic documents – also see Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 5) further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55 – Fabbio '089 supports notifications in general as a package attribute which reads on a first signal; and combined with Dziewit '214's support of locking reads on locking an electronic document in response to a first signal – also see

Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).

- (Claim 9) further comprising receiving a second signal indicating that the one or more of the electronic documents are final draft documents (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating that the electronic documents are final drafts – also see Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 11) wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an office action, inventor declaration, assignment, power of attorney, or patent drawings (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").
- (Claim 25) further comprising: receiving a second signal indicating that the one or more electronic documents needs to be edited (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating that the electronic documents are final drafts – also see Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214); and automatically unlocking the one or more documents into an editable form (Dziewit '214: col. 9, lns. 64-67; col. 10, lns. 11-12).

- (Claim 29) wherein the first signal comprises a user moving a document from a first section of a graphical interface to a second section of a graphical interface (Fabbio '089: col. 9, lns. 59-67).

Claim 33:

Regarding Claim 33, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 32 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose: wherein at least one of the plurality of documents is stored on a second computer system (Fabbio '089: col. 10, lns. 11-12 – note documents are on a network), and wherein the computer readable medium comprises further instructions executable by the processor to load the at least one of the plurality of documents from the second computer system onto the computer system prior to locking the one or more of the electronic documents (Dziewit '214: col. 9, lns. 40-53).

Claim 26:

Regarding Claim 26, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 4 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose wherein electronically filing the electronic documents in the patent office comprises transmitting the electronic documents to the patent office via an interface to an electronic filing system of the patent office (Fabbio '089: Fig. 2, item 50).

Claim 6:

Regarding Claim 6, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 5 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose wherein the automatically locking includes automatically



converting the one or more electronic documents from a first document type to a locked image file (Fabbio: '089: col. 12, Ins. 19-23; Dziewit '214: col. 14, Ins. 26-32; col. 14, Ins. 51-55).

Claim 10:

Regarding Claim 10, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 9 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose: wherein each electronic document has a native format type, the method further comprising generating a first lock signal in response to the second signal, and in accordance therewith, automatically locking the one or more electronic documents in their native format types, and generating a second lock signal in response to the first signal, and in accordance therewith, automatically converting the one or more electronic documents from their native format types to locked image files (Fabbio '089: col. 6, Ins. 6-8; Dziewit '214: col. 14, Ins. 26-32; col. 14, Ins. 51-55 – Fabbio '089 supports notifications in general as a package attribute which reads on a first signal in response to a second signal and a second lock signal in response to a first signal; and combined with Dziewit '214's support of locking reads on locking an electronic document in response to a first signal – also see Dziewit '214: col. 1, Ins. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).

Claim 12:

Regarding Claim 12, Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses: a computer-implemented method comprising:

- storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents (Fabbio '089: col. 2, Ins. 56-65); and

- creating a package including one or more of the electronic documents (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that “one or more pieces of information” reads on one or more electronic documents), the package being displayed in a first folder of a graphical user interface (Fabbio '089: col. 3, ln. 58 to col. 4, ln. 12; col. 8, ln. 56 to col. 9, ln. 24).

However, Fabbio '089 does not explicitly disclose:

- automatically locking down the one or more electronic documents in the package when a user transmits a first signal indicating that the package has been transferred from a first phase to a second phase, wherein locking down the one or more documents prevents further editing of the one or more documents; or
- the electronic documents are associated with a patent application.

Dziewit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziewit '214 discloses: a computer-implemented method of controlling document edits (Dziewit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) comprising: automatically locking down the one or more electronic documents in the package when a user transmits a first signal indicating that the package has been transferred from a first phase to a second phase, wherein locking down the one or more documents prevents further editing of the one or more documents (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55). However, Dziewit '214 does not disclose that the electronic documents are associated with a patent application

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to combine the method of Dziwit '214 with the method of Fabbio '089. The motivation to combine is on the same basis as Claim 1 (supra).

It would have been further obvious to a person having ordinary skill in the art to combine the method of Fabbio '089 and Dziwit '214 in combination with the LegalStar '99 disclosure. The motivation to combine is on the same basis as Claim 1 (supra).

Claims 13-16 and 18-19:

Regarding Claims 13-16 and 18-19, Fabbio '089, Dziwit '214, and LegalStar '99 in combination disclose all the limitations of Claim 12 (supra). Additionally, Fabbio '089, Dziwit '214, and LegalStar '99 in combination disclose:

- (Claim 13) wherein the first phase is a final draft phase and the second phase is a ready to file phase (Fabbio '089: col. 6, lns. 6-8; Dziwit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziwit '214 – this reads on the first phase is a final draft phase and the second phase is a ready to file phase);
- (Claim 14) wherein the first phase is a final draft phase and the second phase is a filed phase (Fabbio '089: col. 6, lns. 6-8; Dziwit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to

- an arbitrary business process as described by Dziewit '214 – this reads on the first phase is a final draft phase and the second phase is a filed phase);
- (Claim 15) wherein the first phase is a filed phase and the second phase is a transmitted phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214 – this reads on first phase is a filed phase and the second phase is a transmitted phase);
  - (Claim 16) wherein automatically locking includes automatically converting the one or more electronic documents from a first document type to a locked image file (Fabbio: '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);
  - (Claim 18) wherein the each electronic document has a native format type, the method further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents in their native format types, and generating a second lock signal in response to a second signal indicating the package has been transferred from the second phase to a third phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214), and in accordance therewith, automatically converting the one or more electronic documents from their native format types to locked image files (Fabbio: '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);

- (Claim 19) wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an office action, inventor declaration, assignment, power of attorney, or patent drawings (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").
- (Claim 27) further comprising electronically filing the one or more electronic documents in a patent office (Fabbio '089: col. 6, lns. 6-8; col. 6, lns. 43-44; LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)" – note that the documents are patent application documents, the combination of Fabbio '089 and LegalStar '99 disclose sending the documents to a patent office).
- (Claim 30) wherein the first signal comprises the user moving a document from a first section of a graphical interface to a second section of a graphical interface (Fabbio '089: col. 9, lns. 59-67).

Claim 28:

Regarding Claim 28, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 27 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose wherein electronically filing the one or more electronic documents to the patent office comprises transmitting the electronic documents to the patent office via an interface to an electronic filing system of the patent office (Fabbio '089: Fig. 2, item 50).

Claim 20:

Regarding Claim 20 Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses:

- storing a plurality of electronic documents on a computer system, each electronic document having a native format type (Fabbio '089: col. 2, lns. 56-65);
- creating a package including one or more of the electronic documents (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that “one or more pieces of information” reads on one or more electronic documents);
- receiving from a user a first signal indicating that the package is ready to be filed (Fabbio '089: col. 6, lns. 6-8; col. 6, lns. 43-44 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating electronic documents are to be filed; further note the user creates signals to populate the package attributes); and
- automatically transforming the one or more electronic documents from its native format types into a format type that is viewable as it will be printed (Fabbio: '089: col. 12, lns. 19-23).

However, Fabbio '089 does not explicitly disclose:

- displaying the transformed one or more electronic documents to a remote user; or
- that the filing is in a patent office.

Dziewit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziewit '214 discloses: a computer-implemented method of controlling document edits (Dziewit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) comprising displaying the transformed one or more electronic documents to a remote user.

However, Dziewit '214 does not explicitly disclose that the filing is in a patent office.

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to combine the method of Dziewit '214 with the method of Fabbio '089. The motivation to combine is on the same basis as Claim 1 (supra).

It would have been further obvious to a person having ordinary skill in the art to combine the method of Fabbio '089 and Dziewit '214 in combination with the LegalStar '99 disclosure. The motivation to combine is on the same basis as Claim 1 (supra). Note the automation of the patent filing process as described in the motivation to combine in Claim 1 (supra) suggests that the filing is with a patent office.

Claims 21-22:

Regarding Claims 21-22, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 20 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 21) further comprising locking the transformed one or more documents (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);
- (Claim 22) further comprising generating a signal indicating that the package can be filed (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating that the package can be filed).

Claim 23:

Regarding Claim 23, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 22 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose: further comprising entering the package into an outgoing mail queue (Fabbio '089: col. 3, lns. 9-23 – note that targeting an email address for an output for a package reads on targeting an outgoing mail queue).

Claim 24:

Regarding Claim 24, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 23. Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose further comprising electronically filing the package in a patent office (Dziewit '214: col. 1, lns. 32-59 – note that Dziewit '214 provides for the automation of an arbitrary business process, including electronic filing. Taken in combination with Fabbio '089, and LegalStar '99, this suggests automating the patent filing process which includes electronically filing the package in a patent office).

Claim 31:

Regarding Claim 31, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 24. Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose wherein electronically filing the package in a patent offices comprises transmitting the electronic documents to the patent office via an interface to an electronic filing system of the patent office (Fabbio '089: Fig. 2, item 50).

Claim 35:

Regarding Claim 35, Fabbio '089 discloses: a method of electronically filing a document (Fabbio '089: col. 10, ln. 8) the method comprising:



- storing a document on a computer system (Fabbio '089: col. 2, lns. 56-65);
- receiving a signal from a user that the document is ready to be filed (Fabbio '089: col. 6, lns. 6-8; col. 6, lns. 43-44 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating electronic documents are to be filed; further note the user creates signals to populate the package attributes);
- electronically filing the document via an interface to an electronic filing system (Fabbio '089: Fig. 2, item 50).

However, Fabbio '089 does not explicitly disclose:

- allowing a user to edit the document;
- in response to the signal, automatically locking the document to prevent further edits to the document;
- converting the document from a first document type to a second document type;

Additionally, Fabbio '089 does not disclose that the documents are patent documents and the target destination is a patent office.

Dziewit '214 discloses:

- allowing a user to edit the document (Dziewit '214: col. 9, lns. 40-53);
- in response to the signal, automatically locking the document to prevent further edits to the document (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);
- converting the document from a first document type to a second document type (Dziewit '214: col. 11, lns. 36-40 – note encryption reads on converting from one type (unencrypted) to another (encrypted));

Additionally, Dziewit '214 does not disclose that the documents are patent documents and the target destination is a patent office.

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to apply the electronic document locking means of Dziewit '214 to the electronic document package distribution means of Fabbio '089. The motivation to combine is on the same basis as Claim 1 (supra).

It would have been further obvious to a person having ordinary skill in the art to apply the Fabbio '089 and Dziewit '214 combination for electronic filing of patent documents as per LegalStar '99. The motivation to combine is on the same basis as Claim 1 (supra).

Claims 36 and 37:

Regarding Claims 36 and 37, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 35 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 36) wherein the document is selected from the group consisting of a provisional patent application specification, a non-provisional patent application specification, a response to an office action, an inventor declaration, an assignment, a power of attorney, and a patent drawing (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

- (Claim 37) wherein the document is a plurality of documents associated with a patent application, the method further comprising: grouping the plurality of documents into a package to be filed electronically; wherein electronically filing the patent document comprises electronically filing the package (Fabbio '089: col. 10, lns. 14-17).

3. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabbio '089, Dziewit '214, and LegalStar '99 in combination in view of the publication, "Design, Implementation, and Evaluation of a Revision Control System" by Tichy, published 1982 (hereafter Tichy '82).

Claims 7 and 17:

Regarding Claims 7 and 17, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 6 and 16 (supra). However, Fabbio '089, Dziewit '214, and LegalStar '99 in combination do not explicitly disclose: further comprising displaying the locked image files in a file history portion of a graphical user interface, wherein the file history portion of the graphical user interface provides a record of documents submitted to a patent office.

Tichy '82 discloses a revision control system. Specifically, Tichy '82 discloses: further comprising displaying the locked image files in a file history portion of a graphical user interface (Tichy '82: pp. 61-62, section 2.3 - note the file history capability).

It would have been obvious to a person having ordinary skill in the art to combine the file history of Tichy '82 to the Fabbio '089, Dziewit '214, and LegalStar '99 combination. The motivation to combine is suggested by Tichy '82 which discloses the advantage of providing maintainable tracking of changes in a set of documents undergoing constant modification such as

that of the Fabbio '089, Dziewit '214, and LegalStar '99 combination (Tichy '82: p. 58, section 1).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fabbio '089, Dziewit '214, and LegalStar '99 in combination in view of the web site [www.adobe.com](http://www.adobe.com) as archived by the WAYBACK MACHINE (TM) ([www.archive.org](http://www.archive.org)) on January 25, 1999 (hereafter Adobe '99).

Claim 8:

Regarding Claim 8, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 5 (supra). However, Fabbio '089, Dziewit '214, and LegalStar '99 in combination do not explicitly disclose: wherein the locked image file is a locked .pdf file.

Adobe '99 discloses .pdf locking. Specifically, Adobe '99 discloses: wherein the locked image file is a locked .pdf file.

It would have been obvious to a person having ordinary skill in the art to substitute the locked .pdf file of Adobe '99 for the locked image file of the Fabbio '089, Dziewit '214, and LegalStar '99 combination. The motivation to combine is suggested by Adobe '99 which discloses the advantage of providing protection during distribution to legal documents such as the patent documents in the Fabbio '089, Dziewit '214, and LegalStar '99 combination (Adobe '99: p. 1 of 3, section titled, "Protect documents with security controls").

***Response to Arguments***

5. Applicant's arguments filed November 10, 2004 have been fully considered but they are not persuasive. Applicant's arguments are addressed as follows:

A. Fabbio '089 discloses receiving a notification from a user.

Claim 1 recites in part, "... receiving from a user a first signal indicating that one or more of the electronic documents are to be filed..." (Amendment: p. 6, Claim 1, Ins. 8-9). Applicant argues that because a notification, once created, is "from the system to the user" (Amendment: p. 15, Ins. 12-13), that the user is not involved. However, this argument ignores that the user creates the notification in the first place. Specifically, Fabbio '089 discloses a package attribute data structure, including notification data (Fabbio '089: col. 6, Ins. 6-8). Furthermore, Fabbio '089 discloses that the user populates this data structure (Fabbio '089: col. 6, Ins. 43-44). **The act of populating this data structure which includes notification information reads on receiving a notification from a user.**

B. Dziewit '214 discloses a non-editable form.

Applicant argues that because Dziewit '214 allows preauthorized users to edit the file, that the file is not in a non-editable form (Amendment: p. 15, Ins. 22-28). However, Applicant admits that the file is locked from "unauthorized access or modification" (Amendment: p. 15, Ins. 26-27). **Examiner points out that the claims are silent as to whom the file is non-editable. As such, the claims as currently written read on files non-editable to a subset of users as well as files**

**non-editable to all users.** As per MPEP 2111, Examiner is obliged to read claims with the “broadest reasonable interpretation.” Thus Dziewit ‘214 reads on this limitation.

In general, the features upon which applicant relies (i.e., non-editable to all users) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- C. LegalStar ‘99 in combination with Fabbio ‘089 and Dziewit ‘214 disclose a signal indicating that such documents are to be filed in a patent office.

Despite Applicant’s argument that LegalStar ‘99 in isolation does not disclose “a signal indicating that such documents are to be filed in a patent office”

(Amendment: p. 16, lns. 17-20), Examiner points out that LegalStar ‘99 in combination with Fabbio ‘089 and Dziewit ‘214 disclose such an indication.

Fabbio ‘089 discloses receiving package attributes with delivery information from the user (Fabbio ‘089: col. 6, lns. 6-8; col. 6, lns. 43-44). Since LegalStar ‘99 regards patent application documents, very naturally the documents would be routed to a patent office. Thus Fabbio ‘089 and LegalStar ‘99 in combination (and combined with Dziewit ‘214 to address other limitations in the claim), read on “a signal indicating that such documents are to be filed in a patent office.”

In general, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- D. Fabbio '089 discloses authentication as well as motivation to combine with Dziewit '214.

While Applicant asserts that Fabbio '089 does not require authentication (Amendment: p. 17, ln. 9), Examiner points out that **Fabbio '089 in fact discloses authentication services** (Fabbio '089: Fig. 2, item 66). Furthermore, while Applicant asserts that running an authentication service in its own process, such as Dziewit '214, precludes combination (Amendment: p. 17, ln. 11), Examiner points out that **Fabbio '089 discloses authentication services as separated from delivery services** (Fabbio '089: Fig. 2, items 66 and 56). Because Fabbio '089 does not explicitly disclose particular aspects of an authentication service, a person having ordinary skill in the art is motivated to combine Fabbio '089 and Dziewit '214, and moreover has a reasonable expectation of success.

- E. Miscellaneous arguments.

Applicant concludes with several arguments directed at random claims.

- Regarding Claim 4, Applicant asserts that there is not motivation to file a document with a patent office (Amendment: p. 18, lns. 4-5). Examiner reiterates Argument C.
- Regarding Claim 3, Applicant asserts that manual verification is precluded (Amendment: p. 18, lns. 17-19). Examiner reiterates Argument B which demonstrates that the claim language, as currently written, allows some users to access the file manually, but locks others out.
- Regarding Claim 6, Applicant claims that an automatic locking process is not disclosed (Amendment: p. 18, ln. 28). Examiner points out citation in the Office Action (Fabbio '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55) and reiterates that the references may not be attacked in isolation as per *In re Keller* in Argument C (supra).
- Regarding Claim 7, Applicant claims that because Tichy dates from 1982, the file history of Tichy could not be combined with a graphical user interface. First, graphical user interfaces predate 1982 (note <http://sloan.stanford.edu/MouseSite/1968Demo.html> which contains Doug Engelbart's original demos including that of a graphical user interface). Second, Tichy must be seen in combination with Fabbio '089, which has a graphical user interface (Fabbio '089: Abstract).
- Regarding Claim 9, Applicant claims that a notification cannot read on a first and a second signal. Examiner points out that the signal is a data structure being populated by a user as per Argument A. When the user, or for that



matter and external user, makes multiple actions, both a first and second signal can be made using the same infrastructure.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J Santos whose telephone number is 571-272-4028. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos  
February 18, 2005

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**